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| 09/807,938 | 07/23/2001 | Hugo De Winter | Q64233 | 7504 |
| 7590 01/13/2004 | | | EXAMINER | |
| Sughrue Mion Zinn Macpeak & Seas 2100 Pennsylvania Avenue N W Washington, DC 20037-3213 | | | ORTIZ, ANGELA Y | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,938

Applicant(s)

DE WINTER ET AL.

Examiner

Angela Ortiz

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-20, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 4-7, 21-24 and 27-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Jourquin et al., USP 5,662,996 for the reasons cited in the previous office action.

The cited reference teaches the claimed multi-layered part comprising an elastomeric molded skin, a foam-backing layer, and a synthetic carrier layer. The elastomeric skin layer is polyurethane material. The foam-backing layer may be a flexible polyurethane foam material. The carrier can be produced using PU systems or SRIM systems. Note that figure 1 depicts a coarse side-facing surface for the carrier, and as the materials are the same as those claimed, it is deemed inherent within the reference the plastic carrier shows a coarse surface on its side directed toward the skin. See col. 2, lines 27-55; col. 3, lines 11-40.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 8-16, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gruenwald et al., USP 6,214,272 in view of Jourquin et al., USP 5,662,996 for the reasons cited in the previous office action.

The cited primary reference teaches the basic claimed method of molding a multi-layered synthetic part including molding a first resin, molding a second resin adjacent the first resin, and then molding a third resin adjacent the second to form the final part. The first resin comprises polyethylene and is preferably sprayed onto the mold surface, or can be applied as a powder material onto a heated mold surface, and rotated to cover the mold surface. Each subsequent material layer can be applied as the first resin layer. Note that the first resin layer becomes the outer skin layer of the part being molded. The second material is preferably a foam core substrate. See col. 3, lines 35-45, 50-60; col. 4, lines 35-40; col. 5, line 53 to col. 6, line 35.

The primary reference does not set forth the instant claimed materials, although it does teach that other conventional materials may be used.

The added reference teaches the basic claimed multi-layered part comprising an elastomeric molded skin, a foam-backing layer, and a synthetic carrier layer. The elastomeric skin layer is polyurethane material. The foam-backing layer may be a flexible polyurethane foam material. The carrier can be produced using PU systems or SRIM systems. Note that figure 1 depicts a coarse side-facing surface for the carrier, and as the materials are the same as those claimed, it is deemed inherent within the reference the plastic carrier shows a coarse surface on its side directed toward the skin. See col. 2, lines 27-55; col. 3, lines 11-40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the materials set forth in the added reference, when performing the process set forth in the primary reference, as such materials are

conventional in the art and are deemed equivalent to those disclosed, and the process lends itself to being performed with various conventional materials.

With respect to claims 3 and 10, see USP 6,214,272, for the conventionality of spraying as claimed, at col. 3, lines 35-45.

With respect to claims 2, 16, 25-26, see the added reference USP 5,662,996 at col. 3, lines 20-40.

With respect to claims 8-11, see the molding techniques set forth in USP 5,662,996 at col. 3, lines 30-62.

With respect to claims 12-15, note that a textured leather appearance is desired in USP 5,662,996, see col. 4, lines 20-40. Such can be applied to the mold surface or the finally molded part as a finishing layer.

Double Patenting (for duplicate claims)

Claims 27-32 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 4-7. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The subject matter added to claims 4-7 is so close in content to claims 27-32 that both are deemed to cover the same thing. As claims 4-7 are indicated allowable, claims 27-32 should be canceled. However, applicants may cancel claims 4-7 and allow claims 27-32 to pass to issue.

Allowable Subject Matter

Claims 4-7, 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 22 October 2003 have been fully considered but they are not persuasive.

Applicant argues that the thermoplastic material is applied in a molten state, and this feature is not met in the applied prior art.

The instant claim uses open language by including the word comprising, thus additional steps may be included. In USP 6,214,272, the reference teaches that the second layer is loaded onto the mold as a resin charge, as set forth in col. 3, lines 45-65, and that the mold is heated to a temperature beyond the melting point of the resin which causes the resin to melt and stick to the inner surface of the mold; the resin is therefore being applied in a molten state in a mold containing the desired back surface of the preformed skin material. The instant claims do not preclude the use of a powder material that is heated to the molten state.

Applicant argues that the applied Jourquin reference does not teach thermosetting resin for the carrier material.

Please note that polyurethane materials can be either thermosetting or thermoplastic. The reference discloses both PU and TPU, which are different materials.

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Applicant is redirected to col. 2, lines 27-55 and col. 3, lines 11-40 of the applied reference which set forth PU materials, and col. 4, lines 4-19, which set forth TPU materials. PU resins include a family of resins produced by reacting di-isocyanate with organic compounds to form polymers having free isocyanate groups, that react with each other or water or glycols to form thermosetting materials. TPU, particularly foams, are made by reacting polyisocyanate with a polyol and water. In the applied reference, the skin material formed is not preferably foam because it is desired that the skin give the look of leather, which is not necessarily open-celled in configuration. Note that Jourquin includes a variant of the first embodiment, namely a TPU skin, and a thermosetting carrier, which is the embodiment argued by the applicant. However, the instant claim language is open, and the claimed thermosetting skin is deemed readable on the above-described PU skin material, wherein the thermoplastic foam material layer is readable on the claimed thermoplastic carrier. The additional step of applying a thermosetting carrier while disclosed in the applied reference, may or may not be included when meeting the limitations of the claimed method. Note that the applied primary reference to Gruenwald includes a sprayed skin material to the mold, and a subsequently applied thermoplastic carrier material. The skilled artisan would have been motivated to include the use of thermosetting skin materials as disclosed in the added reference, when performing the process set forth in the primary reference, to obtain a desirable leather appearance on the finally molded article. Note that the added secondary reference clearly teaches as conventional the use of thermosetting resins being molded integrally with thermoplastic resins.

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With respect to claims 3 and 8, note that the materials used can be applied from reaction mixtures as referred in USP 5,662,996 at col. 3, lines 30-62. Note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Clearly the skilled artisan would apply the conventional materials using any number of conventional methods available when performing the process as claimed.

With respect to claims 17-20, note that the rejection of claims 17, 19, 20 is clear on the record and remain as previously applied and repeated above. Reconsideration has been given to claim 18, and this claim is not deemed allowable over the applied prior art reference as the claimed laminate is deemed readable on the separately formed skin material and foam backing material. Note that while separately molded, when the carrier is applied, the materials are integrally formed as a laminate. The rigid carrier material is further described in one embodiment at col. 5, lines 28-35 of USP 5,662,996 as the reaction mixture of polyol and polyisocyanate, typically used for TPUs.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Ortiz whose telephone number is 703-308-4446. The examiner can normally be reached on Monday-Thursday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 703-305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Angela Ortiz
Primary Examiner
Art Unit 1732